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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,515	06/01/2001	Wolfgang Otter	7781.0029-00	1508
22852	7590	04/04/2006	EXAMINER HILLERY, NATHAN	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT 2176	
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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/872,515

Applicant(s)

OTTER ET AL.

Examiner

Nathan Hillery

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 1/6/06.
2. Claims 16 – 34 are pending in the case. Claims 16, 24 and 26 are independent.
3. The rejection of claims 16 – 30 under 35 U.S.C. 103(a) as being unpatentable has been withdrawn as necessitated by amendment.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16 – 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turpin et al. (US 5745712 A) and further in view of Emmet et al. (US 20020129006 A1), Rivette et al. (US 6389434 A) and Agostino et al. (US 6519452 B1).

6. **Regarding independent claim 16,**

a. Turpin et al. teach that *in a preferred embodiment, value trees select a conclusion based on the first condition that is satisfied (although this preference may be modified to suit the needs a particular embodiment). For simplicity to the user, however, the conditions are typically positioned in the order that they should be evaluated. In the preceding example, for instance, the condition >20 should be the first condition in the value tree* (Column 24, lines 9 – 17) as illustrated in Figs 36A-B, compare with **the logic view including nodes representing the layout items and, the position of the nodes defining a**

**processing order of the layout items**, that *thus, the properties of objects may be visually manipulated. Properties are also conveniently inspected. Properties of a field can be inspected, for instance, by clicking on it with the right mouse button* (Column 22, lines 31 – 34), compare with **the property view displaying properties of the layout items**, and that *FIG. 15 illustrates the ability of the system of the invention to highlight the selected path in a tree for the user* (Column 17, lines 1 – 2), compare with **the layout view displaying the layout items in their positions in the form**; that *as shown in FIG. 37D, the value tree now shows a branch 631, but no condition or conclusion. A dotted rectangle surrounds the conclusion node, showing that it is selected* (Column 24, lines 59 – 61), compare with **selecting a layout item in one of the logic, property, and layout views**; that *in the Form Tool, lets the user select multiple objects in order to perform editing operations, assign or revise properties, or reposition the selected fields as a group of objects* (Column 6, lines 38 – 41), compare with **modifying the selected layout item in one of the views**; and that *FIG. 4 represents the major divisions of the "form image data file" which is generated during form creation..* (Column 12, lines 63 – 64), compare with **creating a form definition document based on the modified selected layout item**.

b. Turpin et al. do not explicitly teach **display labels, associated with the nodes, indicating structure information of the form**; **displaying simultaneously a logic view, a property view, and a layout view**; **displaying**

**the layout item as selected in one of the views other than the view in which the layout item was selected**

c. However, Emmet et al. teach that *in this regard, pursuant to an example embodiment of the present invention, the application server provides the user at the client personal computer with visual representation of the document with identifiable tags or labels. These visual tags or labels are provided to facilitate user modification of the underlying tree data structure of the document as formatted for a large form factor display. The user then modifies the tree data structure by, for example, deleting entries, moving entries, and changing labels assigned to various nodes of the data structure to form a modified data structure. This modified data structure is then later used by the application server to reformat the associated document for display at a small form factor display of a client* (Block 0018), compare with **display labels, associated with the nodes, indicating structure information of the form.**

d. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Turpin et al. with that of Emmet et al. because such a combination would provide the users of Turpin et al. with a *system and method for presenting content developed for display on large form factor devices (e.g., PC monitors) on small form factor screens of handheld devices* (Block 0013).

e. Neither Turpin et al. nor Emmet et al. explicitly teach **displaying simultaneously a logic view, a property view, and a layout view; displaying**

**the layout item as selected in one of the views other than the view in which the layout item was selected.**

f. Rivette et al. teach that *The present invention supports a number of modes for displaying the contents of the notes database 308. These modes are called views. The invention supports a note centric view (also called a note view), an object centric view (also called an object view), a link centric view (also called a link view), and a user-defined view. A user can elect to print the notes database 308 while in any of these views, such that the print out has the same appearance to that which is displayed on the computer display. Users can select any of these views to display the contents of the notes database 308. Users can also alternate between these views. Further, users can simultaneously display multiple views of the notes database 308. This is shown in FIG. 43, for example, where the user has elected to display the note view in a window 4304, the link view in the a window 4306, the object view in a window 4308, and the user-defined view 4310. By utilizing multiple windows, such as windows 4304, 4306, 4308, 4310, the user can simultaneously display different views of the same or different portions of the notes database 308* (Column 17, lines 5 – 23), compare with **displaying simultaneously a logic view, a property view, and a layout view.**

g. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Turpin et al. and Emmet et al. with that of Rivette et al. because such a combination would allow the users of Turpin et

al. and Emmet et al. the benefit of *a system and method of linking notes to data objects* (Column 3, line 67).

h. Neither Turpin et al., Emmet et al., nor Rivette et al. explicitly teach **displaying the layout item as selected in one of the views other than the view in which the layout item was selected.**

i. Agostino et al. teach that *simultaneously display the analyzed data in two or more interface views; and adjust at least one network parameter based on the analyzed data, whereby the simultaneously displayed data is depicted in such a manner that interface views are synchronized such that individually selecting a data point in any view updates respective information in all other views* (Column 2, lines 55 – 61), compare with **displaying the layout item as selected in one of the views other than the view in which the layout item was selected.**

j. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Turpin et al., Emmet et al., and Rivette et al. with that of Agostino et al. because such a combination would allow the users of Turpin et al., Emmet et al., and Rivette et al. the benefit of *a post-operation data processing system and method* (Column 2, line 3).

7. **Regarding dependent claim 17**, neither Turpin et al. nor Emmet et al. explicitly teach **reflecting the modifications to the selected layout item in one of the views in which the modification was not made.** Rivette et al. teach that *In step 1816, the notes engine 306 links the selected portion of the data object to the new sub-note. In step 1818, the notes engine 306 updates the displays of the data object and the active*

*note so as to graphically reflect this linkage. The notes engine 306 performs steps 1816 and 1818 in the manner shown in a flowchart 2102 of FIG. 21 (Column 30, lines 14 – 19), compare with **reflecting the modifications to the selected layout item in one of the views in which the modification was not made.** It would have been obvious to combine the invention of Turpin et al. and Emmet et al. with that of Rivette et al.*

*because such a combination would allow the users of Turpin et al. and Rivette et al. the benefit of a system and method of linking notes to data objects (Column 3, line 67).*

8. **Regarding dependent claim 18**, Turpin et al. teach that *in the Form Tool, lets the user select multiple objects in order to perform editing operations, assign or revise properties, or reposition the selected fields as a group of objects* (Column 6, lines 38 – 41), compare with **modifying the position of a layout item in the logic view, thereby changing the processing order.**

9. **Regarding dependent claims 19 and 20**, Turpin et al. teach that *both trees are made of nodes. There are branch nodes (restricted and unrestricted) and conclusion nodes. A restricted branch is simply a branch that is associated with a field; an unrestricted branch is not limited to values in a field. An empty node serves as a placeholder, indicating the absence of a tree or the lack of a conclusion after a branch. Every node has a condition except the root branch (the first branch). In a preferred embodiment, a decision is made by reading trees from top to bottom and left to right. Thus, trees are read in much the same way one would read a flow chart: Is Quantity (branch) greater than 25 (condition)? If the answer is yes, then Shipping Method is Commercial carrier. If the answer is no, then evaluate the next condition* (Column 22,



lines 44 – 56), compare with **the logic view comprises a tree view, and wherein the nodes are tree nodes, and the branch nodes include condition nodes to process layout items according to logical statements.**

10. **Regarding dependent claim 21**, Turpin et al. teach that *in accordance with the invention, keyboard entries are checked against "field characteristics" which are assigned to a field during form creation. If a keyboard entry for a field is not consistent with the assigned characteristic, the entered value is rejected and an error message advises the operator of a problem. Such characteristics can be assigned to a field by standard "picture" specifications. Alternatively, requirements for the form of a field input can be established by local form rules which are implemented by decision trees attached to the field. As an option, upon the occurrence of an error in input format, the field in error can be cleared and the prompt returned to that field to continue form completion* (Column 4, lines 30 – 41), compare with **verifying the compatibility of the layout items and the processing order with a predefined data interface of a business application.**

11. **Regarding dependent claim 22**, Turpin et al. teach that *an event tree for a form can initiate actions when a form is opened or closed. For example, a form event tree could have Close as a condition, and @PRINTFORM(FormName) as the conclusion. Every time a user closes that form, it would be printed. A form event tree could have Open as a condition, and @FIELDFIND(Field Name) as a conclusion. In this instance, every time a user opens that form, the specified field would be selected* (Column 29, lines 47 – 54), compare with **generating a form-printing program; and calling the**

**form-printing program by a business application to print a final document based on the form definition document.**

12. **Regarding dependent claim 23**, Turpin et al. teach that *FIG. 15 illustrates the ability of the system of the invention to highlight the selected path in a tree for the user* (Column 17, lines 1 – 2), compare with **highlighting the selected layout item in at least one additional view.**

13. **Regarding claims 24 and 25**, the claims incorporate substantially similar subject matter as claims 16 and 21 and are rejected along the same rationale.

14. **Regarding claims 26 – 30**, the claims incorporate substantially similar subject matter as claims 16 – 21 and are rejected along the same rationale.

15. **Regarding dependent claims 31 – 34**, Turpin et al. teach that *conclusion node: The ending segment of calculation logic that provides a value to the field. A conclusion node is indicated by an inverted triangle placed to the left of the conclusion expression* (Column 7, lines 14 – 17), compare with **the nodes are shaped according to their function.**

### ***Response to Arguments***

16. In response to Applicant's argument that none of the references teach **displaying the layout item as selected in one of the views other than the view in which the layout item was selected**, this argument is moot in view of the new ground(s) of rejection.

17. Applicant's arguments filed 1/6/06 have been fully considered but they are not persuasive.

18. In response to applicant's argument that there is no motivation to combine the references as suggested (pp 10 & 11), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

19. As indicated in the above rejections, Turpin et al. (US 5745712 A) and further in view of Emmet et al. (US 20020129006 A1), Rivette et al. (US 6389434 A) and Agostino et al. (US 6519452 B1) teach every limitation of the claims and provide proper motivation to combine their teachings. Further, it appears Applicant is not fully appreciating the teachings by limiting them to preferred embodiments only.

### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

Doug Hutton  
Primary Examiner  
Art Unit 2176

NH